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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,981	01/03/2002	Hyun Joo Hwang	K-0384	9142

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EXAMINER

TRINH, MINH N

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/033,981	Applicant(s) HWANG, HYUN JOO	
	Examiner Minh Trinh	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 22-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 14, 15 and 21 is/are rejected.
- 7) ☒ Claim(s) 2-3, 6-13, 16-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed on 9/22/04 has been fully considered and made of record. Claims 1-38 are now pending in this application. Claims 22-38 are subject to restriction and/or election for following reasons.

Election/Restrictions

2. Newly submitted claims 22-38 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: because the invention originally (claimed 1-15) and invention newly submitted (claims 22-38) are being related as combination and subcombination. In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention originally (claims 1-15) does not require "a heating part to be coupled to an upper portion of the holding part . . ." "and a compliance part to be coupled to an upper portion of the heating part . . ." etc., (see claim 22. lines 10-15). The invention originally (claims 1-15) has separate utility such as where "a holding part configured to hold a semiconductor device with a vacuum force", and a compliance part configured to properly align the semiconductor device held by the holding part and test socket, etc., (see claim 1, a bout lines 16-23). Also, it is noted Applicant is not entitled to examination of multiple independent inventions in one application. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, newly submitted invention (claims 22-38) is withdrawn from consideration

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as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 4, 5, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayama et al (US 6,104,204). This rejection is set forth in prior Office Action, paragraph 6, dated 6/24/04.

5. Newly added claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayama et al (US 6,104,204).

As applied to claim 21, see Fig. 1 of Hayama which show positioning holes 35A and an associated positioning pin 35B for guiding a head onto a corresponding test socket of the device.

Response to Arguments

6. Applicant's arguments filed 9/22/04 have been fully considered but they are not persuasive.

Applicant argues (see "Remarks, page 22, paragraph 1) that the Hayama et al do not teach the limitation where a compliance part positioned on an upper portion of the heating part as recited in claim 1. The examiner disagrees. Applicant is referred to Fig.

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1 of Hayama et al, which shows at least one of holding part PB having a compliance part IC or 63 positioned on an upper portion of the heating part 36. Therefore, the features as relied by the applicant are satisfied by Hayama et al. Further, it would have been an obvious matter of design choice to configure a compliance part on an upper portion of the heating part depend upon the configuration requirement since applicant has not disclosed that these features are critical, patentably distinguishing features and it appears that the invention would perform equally well with the compliance part being over the heating as shown by the prior art reference (see Fig. 1, depicts that a compliance part IC being over heating part 36). It is noted that the reference IC or 60 represented the broadly claimed "a compliance part" of the present invention.

In light of the above, Applicant's arguments with respect to Hayama et al is moot.

7. This application contains claims 22-38 drawn to an invention other than the originally filed (as discussed above, paragraph 1). A complete reply to the final rejection must include cancellation of nonelected claims 22-38 or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

8. Claims 2-3, 6-12, 13, 16-19 and 20 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

Prior Art References

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art references are cited for their teaching of testing head for IC devices or the like.

Interviews After Final

10. Applicant notes that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing). Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search will be denied. See MPEP 714.13 and 713.09.

Conclusion

11. Please note that for any amendment made to the disclosure and the claims, Applicant requires to point out the support provide numeral references to the claimed limitations as well as support in the disclosure (i.e., page and line numbers and reference number associated with from the drawings) See 37CFR 1.111 and section 2163.06 of the MPEP).

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mt
12/03/04


MINH TRINH
PRIMARY EXAMINER